

Application No. 10/072,190
Filed: February 7, 2002
Confirmation No.: 3763
Group Art Unit: 3673

REMARKS

Claims 4, 6-9, 13-15 and 17-20 have been rejected by the Examiner under 35 U.S.C. § 103. The Examiner has also objected to claims 10 and 11.

Claims 1-4, 6-11, 13-15 and 17-20 are pending in the present application. Claims 4 and 11 are amended herein and support for the amendments can be found throughout the specification and claims as originally filed. Claims 6, 8, 10 and 20 have been cancelled without prejudice, and claims 1-3 have been withdrawn from further consideration. No new matter has been added. Accordingly, claims 4, 7, 9, 11, 13-15 and 17-19 will be pending upon entry of the amendments herein.

Any amendments to the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Applicant respectfully requests reconsideration and withdrawal of the Examiner's objections and rejections in view of the above amendments and the remarks herein.

General Objections

The Examiner objects to the Markush format used in claim 4. Applicant has amended claim 4 to avoid the Markush format, and comply with the Examiner's suggestion. Applicant respectfully submits that the objection has been overcome.

The Examiner also objects to claim 20 as being of improper dependent form for not further limiting the subject matter of a previous claim. Applicant has cancelled claim 20, thereby

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responding to the Examiner's objection. Applicant respectfully submits that the objection has been overcome.

Claim Rejections - 35 U.S.C. §103

Claims 4, 6-9, 13-15, 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,594,759 to Ikeda in view of U.S. Patent No. 5,267,382 to Aulson, et al.

Applicant respectfully traverses the foregoing rejection.

With regard to newly amended claims 4 and 11, Applicant contends that all of the elements for a *prima facie* case of obviousness are not taught or suggested in Ikeda, either alone or in combination with Aulson et al.

Claim 4 is directed to a device for the mechanical decontamination of radioactively contaminated surfaces of mineral materials. As amended, claim 4 also recites the elements of cancelled claims 8 and 10. Similarly, claim 11 is amended to be an independent claim, directed to a device for mechanical decontamination that recites the elements of claims 4, 8 and 10.

The amendments to claims 4 and 11 comply with the Examiner's comments regarding allowable subject matter. The Examiner indicated that claims 10 and 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the Examiner's convenience, however, Applicant instead included the limitations of intervening claims 8 and 10 in independent claim 4, and all of the limitations of claims 4, 8 and 10 in independent claim 11.

Accordingly, pending claims 4 and 11 are not taught or suggested by Ikeda, either alone or in combination with Aulson et al. Claims 4 and 11 are presently directed to allowable subject

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matter, and Applicant respectfully requests reconsideration and withdrawal of the foregoing rejection.

Allowable Subject Matter

Applicant notes that the Examiner's remarks objected to claims 11 and 12, although the "Office Action Summary" indicated an objection to claims 10 and 11. With claim 12 being cancelled in a previous response, Applicant respectfully understood that the Examiner's remarks concerning allowable subject matter were directed to claims 10 and 11, and not claims 11 and 12.

As discussed above, the Examiner indicated that claims 10 and 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In accordance with the Examiner's remarks, Applicant amended claim 4 to include the limitations of claims 8 and 10. Applicant also amended claim 11 to be an independent claim, and include all of the limitations of claims 4, 8 and 10. Thus, pending claims 4 and 11, as well as the claims dependent therefrom, are directed to allowable subject matter.

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CONCLUSION

Based on the foregoing, entry of the amendments and remarks presented herein, reconsideration and withdrawal of all the rejections and allowance of the application with all pending claims are respectfully requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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